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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/633,062
Filing Date: August 01, 2003
Appellant(s): DYL, CHRISTOPHER J.

Faustino Lichauco
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 04 October 2010 appealing from the Office action mailed 05 January 2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:
Claims 1-23.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

6,443,843	Walker et al.	9/2002
2002/0120667 A1	Nakano	8/2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-19 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (US 6,443,843 B1), in view of Nakano (US Pub. 2002/0120667 A1).

Walker discloses a betting game where upon winning, the prize is a product which includes upon any type of sale product including Objects, content, media etc.;

Nakano discloses a system of controlling distributing of multi-media content such as MPEGs by deleting the content from the storage if the allotted time for use has expired.

Regarding claims 1, 6 and 13; Walker discloses a method of providing a product (content, DVDs, CDs, MPEGs, etc.), in an online game, the method comprising: at a server hosting, for transmission, of product certificates (multi-media content) designated as goal-activated content for an online game;

receiving information indicating that a plurality of players is playing the online game on each of a corresponding plurality of clients, (col. 6:35-52), where a plurality of customers linked through a network connection play simultaneously, the customers assigned registered devices which will have to sign on and indicate presence in the network; receiving information indicating that a first player from the plurality of players has completed a game challenge associated with the goal-activated content, (col. 4:6-25); in response to receiving the information indicating that a first player from the plurality of players has completed a game challenge associated with the goal activated content transmitting the goal-activated content to a first client associated with the first player, (col. 1:60- 2:10, col. 2:56-62, col. 3:50-56 and col. 4:6-25);

Walker fails to disclose the specifics limiting dissemination of multi-media content; Nakano discloses distributing copy protected media and limiting the dissemination of multi-media content including instructing the client to delete the content stored on the client, (¶ [0061]).

All of the component parts are known in Walker and Nakano the only difference is that dissemination or sale of a copy protected MPEG is describe in the virtue of a WEB store and Walker describe the purchasing or winning of products from a WEB store, including such as MPEGs or Videos. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to use all available WEB store teachings for the stores used in Walker's invention.

Regarding claims 2, 11 and 14; Walker discloses wherein transmitting the goal-activated content comprises transmitting the goal-activated content to the first client in

response to a determination that the first player has completed the game challenge, (fig. 8, col. 2:56-62) the challenge of course is the winning outcome.

Regarding claims 3, 8 and 16; Walker discloses receiving a history profile from the first client; maintaining a history profile having information about goal-activated content received from the server and sending the history profile to the server, (fig. 5, col. 10:51-67 and 11:30-39), the history profile such as a customer identification number would be received by the system, Indicating the customer's rating and latest purchases and winnings.

Regarding claims 12 and 15; Walker discloses wherein requesting goal-activated content from the server comprises requesting goal-activated content in response to the completion of the challenge, and authentication (col. 14:11-22, fig. 5).

Regarding claims 4, 9 and 17; Walker and Nakano disclose all the limitations of claims 1, 3, 6 and 8 as applied above and Nakano further discloses wherein instructing the first client to delete the goal-activated content comprises instructing the first client to delete goal-activated content stored on the first client in accordance with the history profile, (¶ [0112-117]), wherein the system according to the pause, stop and play commands history calculates how much time is left for viewing the content. It would have been obvious upon reading Nakano to include checking history for proper time periods spent or history of the account to control the deletion system, allowing the player the flexibility to observe the content at his/hers own timeline. It would be predictable to add the history profile to the time limiting aspect of protected content to the already modified Walker/Nakano invention as declared in claims 1, 6 and 13.

Regarding claim 5; Walker and Nakano disclose all the limitations of claim 1 as applied above and Nakano further discloses encrypting the goal-activated content prior to transmission to the first client, (¶ [0058, 0105]), inherent in MPEG files is coded/encrypted materials for the purpose of limiting play to specific media providers. It

would have been obvious to one of ordinary skill in the art at the time of applicant's invention to use the time encryption method in Nakano to establish the viewable period.

Regarding claims 7 and 19; Walker and Nakano disclose all the limitations of claims 6 and 13 as applied above and Nakano further discloses wherein receiving an instruction from the server to delete goal-activated content comprises receiving, upon initialization of an executable program, an instruction to delete the goal-activated content, (¶ [0068]), as discussed above, Nakano limitations directed to the deletion of content are introduced into Walkers Web stores and thus would all be predictable included parts of the combination of Walker and Nakano.

Regarding claims 10 and 18; Walker and Nakano disclose all the limitations of claims 6 and 13 as applied above and Nakano further discloses wherein receiving an instruction from the server to delete goal-activated content comprises receiving an instruction to delete all goal-activated content stored on the client, (¶ [0006]). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include the "delete all content" feature of Nakano with the Walker/Nakano invention as described in claims 1, 6 and 13 as it would to include all special features taught by Nakano upon reading Nakano's invention. It would be obvious to try all elements taught in the invention in order to attempt to maximize improvement of Walker/Nakano invention making it more versatile and easy to use.

Regarding claim 21; Walker/Nakano as described above in claims 1, 6 and 13; disclose a method for controlling access to multi-media content by clients in a multiplayer game, the method comprising: maintaining a state for each player in a multiplayer game, (Walker col. Fig. 8); storing multi-media content for distribution to clients associated with the players in the game, including storing content in association with each of a plurality of states that can be reached by at least some of the players, (Walker col. 3:50-58); determining that a first player associated with a first client has reached a first state, and permitting access to said multi-media content by the first

player, (Walker fig. 8), wherein the combination is obvious to one of ordinary skill in the art as described above in claims 1, 6 and 13.

Regarding claims 22 and 23; Nakano/ Walker disclose all the limitations of claim 21 as applied above and from which claims 22 and 23 depend on, yet Nakano is silent to the type of content being of goal activated. Walker as disclosed above is of analogous art and discloses the achievement of items or content upon the reaching of certain goals. Walker discloses with respect to claim 22; wherein the state for a player comprises the state of having completed a game challenge, (col. 2:56-62), where the game is continually judging the state of the player (win/loss) in each game challenge; the challenge of winning the game. Also Walker discloses with respect to claim 23; wherein determining whether the first player associated with the first client has reached the first state comprises determining whether the player has completed a game challenge, (col. 2:56-62), (has the player won?). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the well-known goal activated features of Walker into the invention of Nakano in order to be a more interesting and entertaining experience for a subscriber to the WEB store.

Claims 20 is rejected under 35 U.S.C. 103(a) as being obvious over Nakano (US Pub. 2002/0120667 A1), in view of Walker (US 6,443,843 B1).

Regarding claim 20; Nakano discloses:

A computer-based multi-media content dissemination-limiting apparatus, (Abstract).

A non-volatile memory element storing data representative of multi-media content, (¶ [0056]), hard disk.

A transceiver for receiving a connection request from a remote client on a network, (¶ [0055]), Internet network connection inherently contains receivers/transmitters for connection.

A processor configured for determining that the content is to be transmitted to the client; causing the transceiver to transmit the goal-activated content, ([¶ [0011] and [0075]]).

Causing the transceiver to transmit a deletion instruction for deleting the goal-activated content from the client, ([¶ [0068]]), instruction of deletion having been sent.

Nakano is silent to the nature of the content to being goal activated yet it speaks of being a game content.

Walker discloses designating content as goal-activated content, (col. 17:65-col. 18:2]), disclosing the need for the player to reach a goal or winning the game before he/she is allowed to that content. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include the goal activated feature of Walker in Nakano's invention to make a WEB store more interesting for subscribers. More so both references describe forms of obtaining products via a WEB store and any combination of the teachings would be obvious to one of ordinary skill in the art at the time of applicant's invention and predictable.

(10) Response to Argument

1. The examiner's position on the combination of Walker and Nakano relies on the fact that Walker discloses the appeal of a challenge offered or risk into the purchase of a product from an online store. The on-line store being a store that is able to sell any number of products already in existence such as the product of Nakano that is a dissemination limited media content. The present application would limit Walker's invention to provide the product of Nakano as an available product for the game.

2. The appellant has argued in page 7 of the appeal brief, in regards to claim 6; "Combination fails to teach or suggest step [a]", and that "step [a] requires " transmitting, to the server, information indicating that a player has completed a challenge from the

on-line game.”” The examiner points that claim 6 is not written with a sequential enumeration and any step can be maid in any order. To that effect the examiner points to Walker (figure 8 and column 12 line 64 through column 13 line 18), where process 800 can be performed by the retailer controller 100, executed by processor 110 or should be noted that it can be wholly or in part be executed by processor 210 of the customer device 200 or by processor 310 of the POS terminal. With that in mind it’s inherent for the system to communicate to the server the outcome if it was executed from another processor separate from the server. Also process steps S870 and S880 following the determination of the outcome, both steps require populating a record of the outcome into the database, (column 16 lines 42-63), which in itself is part of the server or connected via the server.

3. The appellant has argued in page 8 of the appeal brief, in regards to claim 6; “Combination fails to teach or suggest step [d]”, and that “step [d] recites “receiving an instruction from the server to delete the goal activated content.” The examiner again points that claim 6 is not written with a sequential enumeration and any step can be maid in any order. It is understood that Walker need not discuss deleting content nor time limits on products for these are dependent on the type of product being sought by the purchaser and would limit Walker’s invention. Nakano alone discusses the limitation of its product and in Nakano paragraph [0055] reads; “A broadcast\communication receiving block 12 receives broadcast content through an antenna (or a cable) or receives content distributed from a server through a network (for example, a wide area network such as the Internet). The received content is supplied to a recording/reproducing block 13.” That is the

content and its limitations being distributed from a network server to the user, and paragraph [0061] reads; "In the present first embodiment, the recording/reproducing block **13** executes content recording and reproducing operations as instructed by the CPU **11**. For example, in accordance with a content recording or reproducing command given by the CPU **11**, the recording/reproducing block **13** accesses a predetermined area on the hard disk to read or write specified data. If a command for protecting content is given by the CPU **11**, the recording/reproducing block **13** deletes the content of which recording retention period has passed from the hard disk or rejects the reading of the content of which reproducible period has passed from the hard disk." Where the content is deleted from the users hard disk by instruction received by the CPU from the network server.

4. The appellant has argued in page 9 of the appeal brief, in regards to claim 6; "Combination fails to teach or suggest steps [b] and [c]", and that "steps [b and [c] require " requesting multi-media content designated as goal-activated content from the server," and 'receiving the goal-activated content from the server.' The examiner again points that claim 6 is not written with a sequential enumeration and any step can be maid in any order. The examiner points to Walker (column 14 lines 10-23); "A request to play a game for the selected product is received in step **S820**. The request may be received from the customer device **200**, such as a PDA or a dedicated kiosk providing game functionality according to the invention. A selection of a product received in step **S810** may be considered a request to play a game in step **S820**. In some embodiments, only those customers meeting an eligibility standard, such as a minimum customer rating **550**, are eligible to play a game for products according to the invention. Therefore, step **S820** may also include determination of

Art Unit: 3717

whether the customer from whom the request was received meets the eligibility standard." So the selected product means the requested product and by multi-media content, the most commonly known transmissible products at the time of the applicant's invention are known as "MPEGs" or multimedia files for music and videos or downloadable CDs and DVDs, also mentioned in Nakano. Receiving the content from the server is covered by figure 8, step S870 previously discussed.

5. The appellant has argued in bottom of page 9 of the appeal brief, in regards to claim 6; "Placing a bet is not accepting or issuing a challenge" and that "claim 6 requires transmitting to the server, information indicating that a player has completed a challenge from the on-line game". The examiner traverses by citing the following definitions;

A Challenge by dictionary.com is:

a call or summons to engage in any contest, as of skill, strength, etc.

something that by its nature or character serves as a call to battle, contest, special effort, etc.

a call to fight, as a battle, a duel, etc.

A Bet by dictionary.com is:

to wager with

to make a wager

A Wager by dictionary.com is:

something risked or staked on an uncertain event; bet: *to place a wager on a soccer match.*

the act of betting.

the subject or terms of a bet

to risk (something) on the outcome of a contest or any uncertain event or matter; bet.

The examiner points that a challenge is not a bet, but a bet includes a challenge or the engagement in a contest such as a sporting event or contest, having something risked on the outcome of the challenge. In view of a lottery, the challenge is to guess to the winning numbers.

6. In regards of appellant's arguments section 103 rejection of claim 1 on page 13 of brief; *"However, Walker says nothing about these customer devices 200 deleting content. To remedy this, the Examiner appears to switch gears at around paragraph 4 of the claim. At paragraph 4, claim 1's "clients" transition from being Walker's customer devices into a Nakano video recorder."* The examiner's position on the combination of Walker and Nakano relies on the fact that Walker discloses the appeal of a challenge offered or risk into the purchase of a product from an online store. The on-line store being a store that is able to sell any number of products already in existence such as the product of Nakano that is a dissemination limited media content. The present application would limit Walker's invention from providing the product of Nakano as an available product for the game.

7. The appellant has argued on page 13 of the appeal brief, in regards to claim 1; *"As discussed in connection with claim 6, Nakano's video recorder deletes content without having to receive instructions to do so. Thus, nothing ever instructs Nakano to*

delete any content." The examiner points to several paragraphs of Nakano dedicated to the deletion of content [0006], [0061], [0068], [0080] and [0095].

8. The appellant has argued on page 13 of the appeal brief, in regards to claim 1; "*Claim 1 further includes the limitation of "at a server, hosting, for transmission, multi-media content." The Examiner has identified Walker's retail controller as being claim 1's "server." But the only thing Walker's retail controller actually hosts is the lottery. There is no disclosure in Walker of the retail controller 100 hosting multi-media content.*" It is discussed previously that the multi-media content in Walker is just a product sold through the server hosting a game; which is the product of Nakano.

9. In regards of appellant's arguments section 103 rejection of claim 13 on page 14 of the brief; "*Claim 13 includes the limitation of "at the server, designating selected multi-media content as goal-activated content." The Examiner has identified the retail controller 100 as corresponding to the claim's "server." The Examiner has also identified the prize that the shopper hopes to win as being "goal-activated content." The only remaining question then is "Where does the act of choosing the prize (i.e. "designating... goal-activated content") actually occur?"*" The examiner points to Walker (column 4 lines 6-11); "The customer selects a product by selecting a displayed hyperlink corresponding to the product. In response, the web server transmits a web page to the Web browser including a view, a description and a price of the product. The web page also includes a hyperlink selectable to indicate that the customer desires to play a game for the product." So, the use of a server to designate a multi-media content as goal activated is simply the

selection from the player to choose a prize for the game. That is, the product is designated goal-activated when the player decides it want to play for.

10. In regards of appellant's arguments section 103 rejection of claim 21 on bottom of page 14 of the brief; *"The prior art fails to teach or suggest "storing multi-media content for distribution to clients associated with the players in the game, including storing content in association with each of a plurality of states that can be reached by at least some of the players;" According to the examiner, Walker suggests storing a movie "in association with" the state of winning the lottery."* The examiner fails to see where the examiner in reference to claim 21 mentions a movie; **"Regarding claim 21;** Walker/Nakano as described above in claims 1, 6 and 13; disclose a method for controlling access to multi-media content by clients in a multiplayer game, the method comprising: maintaining a state for each player in a multiplayer game, (Walker col. Fig. 8); storing multi-media content for distribution to clients associated with the players in the game, including storing content in association with each of a plurality of states that can be reached by at least some of the players, (Walker col. 3:50-58); determining that a first player associated with a first client has reached a first state, and permitting access to said multi-media content by the first player, (Walker fig. 8), wherein the combination is obvious to one of ordinary skill in the art as described above in claims 1, 6 and 13." Though the examiner offers Walker figure 8 steps S880 and S870 where the disposition of the product is stored in the database according to the state of the game outcome, (column 16 lines 42-63).

11. In regards of appellant's arguments section 103 rejection of claims 3, 8 and 16 on page 16 of the brief; *"Claim 3 is patentably distinct over the art because in Walker,*

the purchase history is not received from a client. Instead it is maintained at the server.

Claim 3 recites the additional limitation of "receiving a history profile from the first client"

Thus, according to the claim, the history profile must be received from the first client."

The examiner points to Walker (column 10, line 51 to column 11, line 39); "FIG. 5 illustrates a tabular representation of a portion of the customer database **500** according to one embodiment of the present invention. The customer database **500** is used to store general information about a customer which may be used by a system according to the present invention. The information stored in the customer database **500** may be obtained by requiring a customer to submit a written registration form requesting certain customer information or by requiring the customer to complete fields of a registration web page transmitted to a customer device via the *World Wide Web...* Each record shown in the illustrated portion of the customer database **500** includes several fields, the fields specifying: i) a customer identifier **510** preferably used throughout the databases of the data storage device **160** to relate data to an associated customer; ii) a name **520** of the associated customer; iii) contact information **530** for use in contacting the associated customer; iv) a payment identifier **540** associated with the customer; and v) a customer rating **550**... The customer rating **550**, in one embodiment, is based on an associated customer's purchasing history. For example, a customer having purchased items resulting in over **\$500** profit for a retailer in a past year is assigned a Gold customer rating **550**, while a customer having purchased items resulting in less than **\$50** in profit is assigned a Bronze customer rating **550**. A customer may also pay a fee in order to be associated with a particular customer rating. The customer rating **550** may be a numerical rating determined according to a rating algorithm or formula." Where the customer database initialized by the player

contains a customer rating field based on customer's history of purchases entered in the registration form.

12. In regards of appellant's arguments section 103 rejection of claims 4, 9 and 17 on page 17 of the brief; "Claim 4 recites the further limitation of "instructing the first client to delete goal-activated content stored on the first client in accordance with the history profile." And "Accordingly, the Examiner's theory that somehow a history of pauses, stops, and plays is somehow relevant to deciding whether to delete content is inconsistent with the evidence. In fact, Nakano's video recorder deletes content based on how long the content has been on disk. This does not depend on how many times the user found it necessary to pause while watching the content. For at least this reason, the section 103 rejection is improper and should be reversed." The examiner points that applicant admits that "In fact, Nakano's video recorder deletes content based on how long the content has been on disk" and that is a form of history profile.

13. In regards of appellant's arguments section 103 rejection of claim 5 on page 19 of the brief; "*Claim 5 recites the additional limitation of "encrypting the goal-activated content prior to transmission to the first client."* The Examiner states that "*inherent in MPEG files is [sic] coded/encrypted materials for the purpose of limiting play to specific media providers.*" Since the Examiner has not provided any evidence of this fact, Applicant assumes the Examiner is attempting to take Official Notice." The examiner points to Nakano paragraph [0058]; "In content reproduction, the recording/reproducing block 13 decodes the MPEG data retrieved from the hard disk for example to generate a video signal and an audio signal." This means that prior to saving the data into the hard drive the system encoded (encrypted) the MPEG file.

14. In regards of appellant's arguments section 103 rejection of claims 10 and 18 on bottom of page 19 of the brief; *"Claim 10 recites the additional limitation of "receiving an instruction to delete all goal-activated content." The Examiner concedes that Nakano fails to teach claim 10's limitation of "receiving an instruction to delete all goal-activated content." However, the Examiner suggests that one of ordinary skill in the art would have found this obvious "to maximize improvement of Walker/Nakano invention by making it more versatile and easy to use."* The fact that the instruction is to delete all goal-activated content is covered by Nakano's invention to delete all MPEGs that have expired, paragraphs [0061] and [0068].

15. In regards of appellant's arguments section 103 rejection of claim 20 on page 21 of the brief; *"Claim 20 recites "a transceiver for receiving a connection request from a remote client on a network" As best understood, the Examiner regards claim 20's transceiver as corresponding to the network interface in the Nakano video recorder. And, Claim 20 also recites the limitation of "causing the transceiver to transmit a deletion instruction for deleting the goal-activated content from the client."* Yes the examiner indicated Nakano paragraph [0055]; "A broadcast communication receiving block 12 receives broadcast content through an antenna (or a cable) or receives content distributed from a server through a network (for example, a wide area network such as the Internet). The received content is supplied to a recording/reproducing block 13." Where the words "antenna", "receiver" and "network" constitute a transceiver (modem), and which all the previous instructions discussed above are being transmitted from and received by.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/FRANK M LEIVA/

Examiner, Art Unit 3717

Conferees:

/Melba Bumgarner/

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